

REMARKS

The Applicants have carefully considered the Office action dated March 18, 2010. By way of this response, the Applicants have amended claims 1, 3, 4, 6-9, 11, 13, 15, 16, 18, 21, 23, and 24 and added new claim 140. It is respectfully submitted that all claims are fully supported by the Applicants' originally filed application and that no new matter has been added. The Applicants respectfully traverse the rejections and submit that all claims are in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested.

I. Objection to the Specification

In the Office action, the specification was objected to based on alleged improper antecedent basis for the claimed computer readable medium of claims 18-25. The Applicants traverse the objection. It is well established that original claims filed with an application form their own antecedent basis. *See MPEP 2163(I) (citing In re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description))*. The Applicants note that the computer readable medium of claims 18-25 appeared in the original filing of the instant patent application and, as such, have antecedent basis in the originally filed specification.

In addition, the Applicants note that the specification states, "The example decoding processes may be implemented by software executed by a processor..." *Applicants' Specification*, ¶ [0078]. Although claims 18-25 are not directed to software *per se*, but to a tangible computer readable medium falling within the article of manufacture statutory class, software may be implemented using instructions stored on a computer readable medium. Thus, support for the computer readable medium of claims 18-25 can also be found in the detailed description of the Applicants' specification at least at paragraph [0078].

Accordingly, the Applicants respectfully request withdrawal of the objection to the specification.

II. The Rejections Under 35 USC § 103

In the Office action, claims 1, 3-9, 11-18, and 20-25 were rejected under 35 USC §103(a) as unpatentable over Holtz et al. (US 2002/0053078) in view of Jones et al. (US 2004/0137929). The Applicants respectfully traverse the rejections.

a. Independent Claim 1

The Applicants respectfully submit that independent claim 1 is in condition for allowance. Independent claim 1 is directed to a method and recites, among other things, retrieving secondary content in response to a trigger at a media decoder (coupled to a media presentation device) based on trigger information, the secondary content being received at the media decoder separately from the media composition, and synchronizing, via the media decoder, a presentation of the secondary content with a presentation of the media composition. The combination of Holtz et al. and Jones et al. does not teach or suggest such a method.

Holtz et al. describe an encoding system that assembles show segments that are subsequently streamed to a media client. *Holtz et al.*, ¶ [0215]. Thus, Holtz et al. describe that assembly of multiple content segments occurs at a server prior to sending to a client. As such, a client receives already synchronized content without having to decode a trigger at a client and separately retrieve secondary content. Thus, Holtz et al. describe the opposite of claim 1. Holtz et al. do not teach or suggest retrieving secondary content in response to a trigger at a media decoder (coupled to a media presentation device) based on trigger information, the secondary content being received at the media decoder separately from the media composition, and

synchronizing, via the media decoder, a presentation of the secondary content with a presentation of the media composition.

Jones et al. describe that a cellular phone at a client side detects a uniform resource locator (URL) in an audio track of a television show and performs further operations of retrieving a web page based on the URL and synchronizing a presentation of the web page with a television program. *Jones et al.*, ¶ [0147]. Thus, Holtz et al. could not be modified in view of Jones et al. to result in the claimed invention, because Holtz et al. describe synchronizing content at an encoding system and streaming or sending the synchronized content to a client, while Jones et al. describe the opposite. Thus, there can be no motivation for such a combination.

Furthermore, modifying Holtz et al. in view of Jones et al. to require synchronizing content at a client side would impermissibly change the principle of operation of Holtz et al., which is to synchronize all the content at a server side by an encoding system and stream or send the already synchronized content to a client. *See MPEP 2143.01 (VI)* (The proposed modification cannot change the principle of operation of a reference.). Because the proposed modification changes the principle of operation of Holtz et al., there can be no motivation for this combination.

In view of the foregoing, independent claim 1 and all claims dependent thereon are in condition for allowance.

b. Independent Claim 9

The Applicants respectfully submit that independent claim 9 is in condition for allowance. Independent claim 9 is directed to an apparatus and recites, among other things, a processor system including a memory in a media decoder to be coupled to a media presentation device, the processor system to retrieve secondary content in response to a trigger at the media decoder based on trigger information, the secondary

content being received at the media decoder separately from a media composition, and synchronize a presentation of the secondary content with a presentation of the media composition. The combination of Holtz et al. and Jones et al. does not teach or suggest such an apparatus. Accordingly, independent claim 9 and all claims dependent thereon are in condition for allowance.

c. Independent Claim 18

The Applicants respectfully submit that independent claim 18 is in condition for allowance. Independent claim 18 is directed to a computer readable medium and recites, among other things, retrieving the secondary content in response to a trigger at a media decoder (to be coupled to a media presentation device) based on trigger information, the secondary content being received at the media decoder separately from a media composition, and synchronizing, via the media decoder, a presentation of the secondary content with a presentation of the media composition. The combination of Holtz et al. and Jones et al. does not teach or suggest such a computer readable medium. Accordingly, independent claim 18 and all claims dependent thereon are in condition for allowance.

III. Conclusion

The Applicants respectfully request reconsideration of this application. If there are any remaining matters that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

In general, the Office action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future

should the need arise (e.g., if any such statement should become relevant by appearing in a rejection of any current or future claim).

The Commissioner is authorized to charge any deficiency in the submitted payment toward payment of any fee due for the filing of this paper to deposit account number 50-2455.

In addition, if a petition for an extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, the Applicants request that the Commissioner consider this paper to be a petition for an appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to the above deposit account.

Respectfully submitted,

HANLEY, FLIGHT & ZIMMERMAN, LLC
(customer number **81905**)
150 South Wacker Drive
Suite 2100
Chicago, Illinois 60606
(312) 580-1020

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By: /Felipe Hernandez/
Felipe Hernandez
Registration No. 61,971
Attorney for Applicants